

**REMARKS**

Claims 1-5, 7, 8 and 10-11 are pending in this application.

Claim 1 has been amended to recite that the reducing agent is a phenol compound. Support for this amendment can be found on page 2, last line of the specification. Claim 1 has also been amended to delete the compounds of Formulae II and IV:

Claims 2, 4, 5, 10 and 11 have been amended for clarity.

The above-amendment does not narrow the scope of the claimed invention.

Claims 6 and 9 have been cancelled.

The first sentence of the specification has been updated to reflect the identity of the parent application on which priority of the present application is based.

No new matter has been added by way of the above-amendment.

***Rejection Under 35 U.S.C. § 112, Second Paragraph***

Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants respectfully traverse the rejection.

The Examiner rejects these claims because the Examiner asserts that there is no antecedent basis for "the compound has" after "A:" and "the compound is" after "B:". In response, Applicants have

amended claim 1 to delete these terms. With these amendments, Applicants believe this rejection has been overcome, and withdrawal of the rejection is respectfully requested.

***Rejection Under 35 U.S.C. §§ 102/103***

The following prior art-based rejections are pending:

- A) Claims 1-6 and 9-11 are rejected under 35 USC §102(b) as being anticipated by, or alternatively, under 35 USC §103(a) as being unpatentable over Kirk '938 (US Patent No. 5,460,938);
- B) Claims 1-5 and 10-11 are rejected under 35 USC §102(e) as being anticipated by, or alternatively, under 35 USC §103(a) as being unpatentable over Kato '663 (US Patent No. 6,174,663);
- C) Claims 1-5 and 10-11 are rejected under 35 USC §103(a) as being unpatentable over the combination of Tsuzuki '121 (US Patent No. 5,677,121) and Milton '336 (US Patent No. 3,544,336);
- D) Claims 1-11 are rejected under 35 USC §102(e) as being anticipated by, or alternatively, under 35 USC §103(a) as being unpatentable over Miura '512 (US Patent No. 6,248,512); and
- E) Claims 1-11 are rejected under 35 USC §102(b) as being anticipated by, or alternatively, under 35 USC §103(a) as being unpatentable over EP '764 (EP 0 803 764).

Applicants respectfully traverse each rejection.

The present photothermographic composition has the advantage over the photothermographic compositions of the cited prior art, since the present photothermographic composition is able to provide

sufficient image density at practical reaction temperatures with practical reaction times and can sufficiently suppress coloration of blank portions during storage in the dark after development. These improved properties are the result of the fact that the composition includes at least one phenol reducing agent and at least one compound having a hydrogen bond formation rate constant  $K_f$  that is 20-4000, and which is represented by the formula (III) or (IV).

We now turn to the merits of the rejections.

Upon review of the cited references, Applicants note that these references neither teach nor suggest compounds of formulae (III) or (IV). Accordingly, Applicants have amended the claims to delete the compounds having a phosphoryl group and the compounds of formula (II) and (V).

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of anticipation or obviousness. See MPEP §§ 2131 and 2143.03. Since none of the cited references disclose compounds of formula (III) and (IV) or suggest that these compounds are useful as disclosed in the present specification, no one skilled in the art would have been motivated to use the compounds of formula (III) and (IV) to achieve the object of the present invention before the claimed

invention was made. Applicants also believe that no one skilled in the art would have predicted that the claimed invention using these compounds exert the advantageous effects disclosed in the present specification.

As such, withdrawal of each of the rejections is respectfully requested.

***Obviousness-Type Double Patenting***

The following rejections are pending:

- X) Claims 1-11 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-7 of Suzuki '684 (US Patent No. 6,514,684); and
- Y) Claims 1-11 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-7 of Yoshioka '237 (US Patent No. 6,696,237).

Applicants respectfully traverse each rejection.

Based on the Examiner's comments in the outstanding Office Action, it appears that the Examiner has cited these patents based on the fact that the inventive claims and the claims in the cited patents recite a compound containing a phosphoryl group.

Accordingly, Applicants have amended the claims to delete the compounds having a phosphoryl group. As such, withdrawal of each of the rejections is respectfully requested.

***Drawings***

Applicants note that this application was filed with two sheets of drawings. However, the Examiner has not acknowledged whether the drawings are acceptable.

Applicants respectfully request that the Examiner acknowledges whether the drawings are acceptable in the next communication.

***Priority Documents***

Applicants respectfully request that the Examiner acknowledges receipt of the priority documents in the parent application Serial No. 09/695,864.

***Conclusion***

In view of the above-comments, Applicants respectfully submit that the claims are now in condition for allowance. A notice to such effect is earnestly solicited.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of three (3) months

to November 20, 2004 in which to file a reply to the Office Action. The required fee of \$980.00 is enclosed herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
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